

REMARKS

Claims 1 - 30 are pending in the application. Claims 1 – 30 are rejected. Claims 19-24 are cancelled. Claims 1-18, and 25-30 remain.

Reconsideration of the pending claims is respectfully requested in view of the following remarks.

It is asserted in the Office Action that Claims 1-3, 6-7, 10-12, 15-16 are rejected under 35 USC 103(a) as being unpatentable over US Patent No. 7,055,167 issued to Masters; in view of WO 00/40021, issued to Edwin Montie et al. Claims 4-5, 8-9, 13-14, and 17-18 are rejected under 35 USC 103(a) as being unpatentable over US Patent No. 7,055167 issued to Masters and Montie; in view of US Patent No. 7,212,740 issued to Boston et al. Claims 19-23, and 25-29 are rejected under 35 USC 103(a) as being unpatentable over Masters, in view of Heuvelman, and further in view of PCT/DP22/10058 issued to Edwin Montie et al., the Examiner maintaining the rejection of the claims based upon the prior art of record, namely Masters and Montie, the Examiner making the following assertions at page 13 of the Office Action:

1. The features upon which Applicant relies “there was no filtering of the displayed information based on usage history” are not recited in the claims, and limitations from the specification are not read into the claims, and
2. “Montie discloses . . . EPG on-screen overview of programs to be selected by a user based on scheduled programs or stored in memory which are selected based on usage history,” citing Montie, page 5, line 15-25 and since usage history is arguably provided by Masters, citing Figure 4, column 8, lines 5-30, the Examiner contends that the combination of Masters and Montie meets all limitations of “an EPG containing only programs based on usage history.”

In response to the first contention that the features upon which Applicant relies are not recited in the rejected claims, it is noted that in Claim 1 step b) clearly provides that a preferred program and preferred duration is based on usage history of the PDR which is used to update

instance description data, and in step c), an EPG is generated based on the updated instance description data. Although the word “filter” is not used, it is clear that the EPG which is generated is based on usage history of the PDR, which is, of course, a filter.

As to the second contention, Montie’s EPG 14 operates by interpreting “DVB-SI data received from the demultiplexor 4 to collect information about the channels available in the received broadcast streams and about the programs scheduled for these channels.” See page 5, lines 15-17. In this connection, Applicant requests the Examiner to take administrative notice of the fact that DVB-SI data is a digital video broadcasting service information standard containing data which is received from an antenna or from a cable network. While Masters discloses usage history as shown in Figure 4, such usage history is to permit the viewer to review the sub-menu (i.e., usage history) and to decide whether he or she wants to watch, record or watch and record the same broadcast content as on the same day of the previous week. The sub-menu 44 lists broadcast programming and activities for the day and segment specified in the sub-menu 42 (column 4, lines 3-5). In other words, the user selects a day of week, and then a time segment such as morning, mid-day or prime time and then sub-menu 44 displays what the user watched and recorded during that period, i.e., day and time segment, of the previous week. It appears that according to Masters, a user can manually combine standard EPG information using a remote control to select programming to be recorded based upon information contained in the sub-menu 44 usage history referred to as viewer log. However, Masters does not generate an EPG as required by step c) of Claim 1, i.e., “the preferred program is outputted on the personal channel at the preferred duration based on the updated instance description data.”

According to MPEP §2142

[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that ‘rejections on obviousness cannot be sustained with mere conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.’ *In re Kahn*, 441 F.3d 977, 988, 78

USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval).

Further, according to MPEP §2143, “[T]he Supreme Court in *KSR International Co. v. Teleflex, Inc.* 550 U.S. ___, ___, 82 USPQ2d 1395-1397 (2007) identified a number of rationales to support a conclusion of obviousness which are consistent with the proper “functional approach” to the determination of obviousness as laid down in *Graham*.” Further, according to MPEP §2143.01, [o]bviousness can be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so. *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1335 (Fed. Cir. 2006). Further, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art.” *KSR International Co. v. Teleflex, Inc.* 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007), and *Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103*, Section III(D), issued by the U.S. Patent and Trademark Office on October 10, 2007. MPEP §2142 further provides:

[a] statement that modification of the prior art to meet the claimed invention would have been “well within the ordinary skill of the art” at the time the claimed invention was made” because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Pat. App. & Inter. 1993).

Since the EPG generating method taught by Montie is simply to use the DVD-SI standard to generate a complete EPG i.e., one which shows all programming and all times provided by a particular service provider, and does not produce an EPG in which “the preferred program is outputted on the personal channel at the preferred duration based on the updated instance description data”, the requirements of MPEP 2142 are not met since the cited references do not even teach all aspects of the claimed invention. That is, in both Montie and Masters, the EPG which is displayed contains all programming provided by the service provider. While Masters provides a sub-menu which shows the user programming which was previously watched during a selected day and time segment, and the user can access the EPG to repeat the same programming

for a current day and time segment by manually selecting from the EPG, neither Monte nor Masters generates an EPG for informing the user that the preferred program is outputted on the personal channel at the preferred duration based on the updated instance description data as required by step c) of Claim 1.

Independent Claim 10 which was rejected on the same basis as Claim 1 contains a similar limitation in its last four lines.

As to the rejection of the remaining independent claims 19 and 25 over Masters in view of Heuvelman and further in view of Montie, Claim 19 contains a similar limitation as to that discussed above with respect to Claim 1 in step d), and independent Claim 25 contains a similar limitation as to that discussed above with respect to Claim 1 in its last five lines. In this connection, Heuvelman was additionally cited with respect to the rejection of Claims 19 and 25, Claim 25 provides in its last five lines that a personal channel controller, in addition to merely generating a personal channel as in Heuvelman, also generates an electronic program guide based on content description data and updated instance description data with limitations corresponding to those of Claim 1. In this connection, since Claim 1 is patentably distinguishable over the prior art of record for the reasons noted above, which reasons are not met by the additional reference Heuvelman, Claim 25 should be considered to be patentably distinct for the same reasons.

As to Claim 19, it does appear that Claim 19, and its dependent claims 20-21 appear to be mainly covered by Heuvelman. Accordingly, Applicant has cancelled Claims 19-24.

Accordingly, reconsideration and withdrawal of the above rejections is respectfully requested.

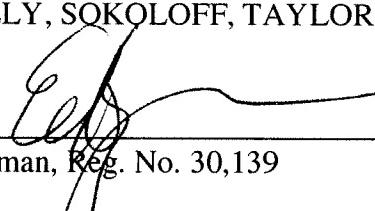
In view of the foregoing, it is submitted that Claims 1-18 and 25-30 patentably define the subject invention over the cited references of record, and are in condition for allowance and such action is earnestly solicited at the earliest possible date. If the Examiner believes a telephone

conference would be useful in moving the case forward, he is encouraged to contact the undersigned at (310) 207-3800.

If there are any additional fees due in connection with the filing of this response, please charge those fees to our Deposit Account No. 02-2666. If a telephone interview would expedite the prosecution of this Application, the Examiner is invited to contact the undersigned at (310) 207-3800.

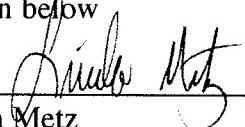
Respectfully submitted,
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN

Dated: 3/11/09


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 3/11/09
Linda Metz March 1, 2009